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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,068	08/30/2006	Gunter Fuhr	P-9039-US	5979
49443	7590	08/27/2010	EXAMINER	
Pearl Cohen Zedek Latzer, LLP			KIM, TAEYOON	
1500 Broadway			ART UNIT	PAPER NUMBER
12th Floor			1651	
New York, NY 10036			MAIL DATE	DELIVERY MODE
			08/27/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/591,068	FUHR, GUNTER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taeyoon Kim	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 52-102 is/are pending in the application.
- 4a) Of the above claim(s) 52-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 97-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/2010 has been entered.

Applicant's amendment and response filed on 1/14/2010 has been entered into the case. Claims 1-51 are canceled, claims 52-96 have been withdrawn from consideration as being drawn to non-elected subject matter, and claims 97-102 have been considered on the merits. All arguments have been fully considered.

### ***Claim Objections***

Claims 97-102 are objected to because of the following informalities: It would be more appropriate to have an article "A" or "The" in front of the claims. Claim 97 would start with "A method...", and the rest of claims would be "The method ..." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1651

Claims 97-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelrine et al. (US 2002/0106314).

Pelrine et al. teach a method of manipulating biological cells bound onto magnetic particles (cell carrier) (par. 26; Fig. 2), which is able to levitate on the diamagnetic surface (solid base surface) (par. 124).

The magnetic particles of Pelrine et al. have a bottom element (see Figures 3, 9, 10, 14).

Pelrine et al. also teach the surface of the magnetic particle having a maximum dimension ranging from about 1  $\mu\text{m}$  to about 2 mm (2000  $\mu\text{m}$ ), about 50 to about 500  $\mu\text{m}$  or about 25 to about 250  $\mu\text{m}$  (par. 124), and thus meet the limitation of the claimed range.

With regard to the limitations of claim 98, 100 and 101 drawn to the cells being positioned next to each other, and interacting/contacting each other or cytological imprinting of cells on neighboring cell carriers, these limitations merely state the result of the limitations in the claim and/or the intrinsic property of the cells on the cell carriers, and therefore, adds nothing to the patentability or substance of the claim. Therefore, this phrase does not limit the claim. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Since the method of Pelrine et al. can provide the same results of contacting or interacting between cells bound to the magnetic particles, it is considered that the method of Pelrine et al. is capable of carry out the same intended results. Furthermore, the limitation of cytological imprinting of cells is solely dependent on the property of cells used in the method rather than the limitation is carried out by the method steps of the current invention. Thus, it is considered

Art Unit: 1651

intended results/outcome produced by the method being used in an application wherein cells being activated by contacting other cells or cell components.

With regard to the limitation of claim 102 drawn to the magnetic force acting on the cells and/or the cell carrier, the method of Pelrine et al. inherently carries out this limitation, and thus, the method of Pelrine et al. anticipates the claimed limitation.

Thus, the reference anticipates the claimed subject matter.

### ***Response to Arguments***

Applicant's arguments filed 1/14/2010 have been fully considered but they are not persuasive.

Applicant alleged that the claimed method utilizes a cell carrier comprising a bottom element, and arranged such that the cell carrier can be displaced on a solid base surface, and the cell carrier has a lateral dimension of 10  $\mu\text{m}$  to 1 cm, and a height of 0.5  $\mu\text{m}$  to 2000  $\mu\text{m}$ .

Applicant alleged that the Pelrine reference does not disclose, teach or suggest the elements of the claimed invention, particularly, the cell carrier comprising a bottom element.

Applicant argued that Pelrine teaches a levitating particle device in which magnetic microparticles and/or effectors are levitated adjacent a diamagnetic surface.

It is acknowledged that the movement of the microparticles of Pelrine is via levitating the particle above the solid surface by magnetic force. However, the particle of Pelrine meets the limitation of "can be displaced on a solid base surface" which is understood such that the carrier sitting on the surface would be "detached" from the solid base surface.

This interpretation is based on the specification which discloses at p.3:

"In terms of the device, the present invention is based according to a first aspect on the general technical teaching of providing a cell carrier for receiving a biological sample, which contains at

Art Unit: 1651

least one magnetic element that makes it possible to move or position the cell carrier by means of a magnetic force, wherein a bottom element is provided, by means of which **the cell carrier can be placed and displaced on a solid surface in a mechanically stable manner**. By providing the bottom element, which forms a support on an underside of the cell carrier, positional stability of the cell carrier is advantageously achieved both in the rest state and in the state in which it is moved in particular by the magnetic force.”

The above disclosure indicates that the cell carrier can be detached from the surface of the solid base, which be considered the same as “levitating” movement of Pelrine’s particles.

Thus, it is the Examiner’s position that the teaching of Pelrine anticipates the claimed invention.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taeyoon Kim whose telephone number is (571)272-9041. The examiner can normally be reached on 8:00 am - 5:00 pm ET (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taeyoon Kim/  
Primary Examiner, Art Unit 1651